The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT A. CORDERY,
DAVID K. LEE, LEON A. PINTSOV,
FREDERICK W. RYAN and MONROE A. WEIANT

Appeal No. 2004-1303
Application 09/650,174

ON BRIEF

Before FRANKFORT, NASE and DIXON, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 35 and 36, the only claims remaining in this application. Claims 1 through 34 have been canceled.

As noted on page 1 of the specification, appellants' invention generally relates to certification of users for electronic commerce, and more particularly, to a secure user certification system and method for electronic commerce that provides an accounting system for services provided. Independent claim 35, directed to a method for validating a signed digital message, is representative of the subject matter on appeal and a copy of that claim can be found in Appendix A of appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Fischer '877	4,868,877	Sept. 19, 1989
Kuzma	5,771,289	June 23, 1998

Claims 35 and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fischer '877 in view of Kuzma.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejection, we refer to the examiner's answer (Paper No. 17,

mailed November 18, 2003) and to appellants' brief (Paper No. 16, filed October 6, 2003) for a full exposition thereof.

OPINION

Having carefully reviewed the obviousness issues raised in this appeal in light of the record before us, we have come to the conclusion that the examiner's rejection of claims 35 and 36 under 35 U.S.C. § 103 will not be sustained. Our reasoning in support of this determination follows.

In rejecting claims 35 and 36 under 35 U.S.C. § 103(a), the examiner has determined that Fischer '877 discloses a method for validating a signed digital message including the steps of receiving a signed digital message from a sender, and validating the signed digital message using a public key of the sender. What the examiner finds lacking in Fischer '877 is any disclosure or teaching concerning a payment scheme for validating the digital message, and more specifically, no disclosure of a register having funds stored therein; determining if sufficient funds are present in the register for validating the message; and

deducting funds from the register for validating the message, as required in claim 35 on appeal. To account for these differences, the examiner looks to Kuzma, urging that Kuzma teaches a method and apparatus for transmitting electronic data using attached electronic credits to pay for the transmission, and teaches use of a register having funds stored therein, determining if sufficient funds are available in the register for validating a message, and deducting funds from the register for validating the message. The examiner then concludes that it would have been obvious to one of ordinary skill in the art at the time of appellants' invention to modify the method of Fischer '877 to include determining if sufficient funds are available for processing validation of a message, and charging the consumer or deducting funds from the register for validating the message. The motivation for this combination of the features in Fischer '877 and Kuzma is said to be "to guarantee payment to the entity providing the service of validating the message (see Kuzma, Col. 8, lines 59-65)" (answer, page 3).

After a careful evaluation of the teachings and suggestions to be derived by one of ordinary skill in the art from Fischer '877 and Kuzma, it is our opinion that the examiner has failed to meet his burden of establishing a ***prima facie*** case of obviousness. More particularly, we are of the view that the examiner's reasoning in support of the obviousness rejection before us on appeal (as expressed on pages 3-6 of the answer) is essentially based on appellants' own disclosure and teachings, uses claims 35 and 36 on appeal as a road map to seek out and combine disparate features from selected pieces of unrelated prior art, and relies upon impermissible hindsight in an effort to reconstruct the presently claimed invention.

Basically, we share appellants' views as aptly expressed in the brief (pages 4-12) concerning the examiner's attempted combination of Fischer '877 and Kuzma, and particularly appellants' assessment that neither Fischer '877 nor Kuzma, considered alone or in combination, discloses, teaches or suggests a method for validating a signed digital message that includes providing a register having funds stored therein, and

after receiving a signed digital message, determining if sufficient funds are available in the register for validating the message, deducting funds from the register for validating the message, and validating the message using a public key of the sender. Moreover, like appellants, it is our view that even if one of ordinary skill in the art would have been motivated to combine the teachings of Fischer '877 and Kuzma, the result would not be that urged by the examiner, but would logically be a method and system to pay a transmission service for the electronic transmission of a digital message (as taught in Kuzma), wherein the digital message was authenticated and signed by a trusted third party, such as a governmental agency (as taught in Fischer '877).

Since we have determined that the examiner has failed to establish a ***prima facie*** case of obviousness with regard to the claimed subject matter before us on appeal, the decision of the

examiner to reject claims 35 and 36 of the present application under 35 U.S.C. § 103(a) is reversed.

REVERSED

CHARLES E. FRANKFORT)
Administrative Patent Judge)
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)
JEFFREY V. NASE) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
JOSEPH L. DIXON)
Administrative Patent Judge)

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